

REMARKS

Claims 1 – 4 and 7 – 11 are presented for reconsideration and further examination in view of the foregoing amendments and following remarks. Claims 5 and 6 were previously canceled and claims 12 – 22 were previously withdrawn.

In the outstanding Office Action, the Examiner rejected claims 1, 2 and 4 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,063,014 to Cakmakci (hereinafter referred to as “the Cakmakci ‘014 patent”); rejected claims 1, 2 and 4 under 35 U.S.C. §102(e) as being clearly anticipated by U.S. Patent No. 6,231,327 to Shanahan et al. (hereinafter referred to as “the Shanahan et al. ‘327 patent”); rejected claims 3 and 9 under 35 U.S.C. §103(a) as being unpatentable over the Shanahan et al. ‘327 patent in view of U.S. Patent No. 4,597,821 to Munro (hereinafter referred to as “the Munro ‘821 patent”); rejected claim 7 under 35 U.S.C. §103(a) as being unpatentable over the Shanahan et al. ‘327 patent in view of U.S. Patent No. 5,693,174 to Nakata et al. (hereinafter referred to as “the Nakata et al. ‘174 patent”); rejected claim 8 under 35 U.S.C. §103(a) as being unpatentable over the Shanahan et al. ‘327 patent in view of reference no. WO98/04390 to Hasenkamp et al. (U.S. Patent No. 6,432,237 being an English language translation thereof and hereinafter referred to as “the Hasenkamp et al. ‘237 patent”); rejected claim 10 under 35 U.S.C. §103(a) as being unpatentable over the Shanahan et al. ‘327 patent the and Munro ‘821 patent in view of the Hasenkamp et al. ‘237 patent; rejected claim 11 under U.S.C. §103(a) as being unpatentable over the Shanahan et al. ‘327 patent in view of U.S. Patent No. 3,239,402 to Ecklund et al. (hereinafter referred to as “the Ecklund et al. ‘402 patent”); rejected claims 1, 3, 4 and 9 under 35 U.S.C. §103(a) as being unpatentable over the Munro ‘821 patent in view of U.S. Patent No. 3,524,781 to Winterroth et al. (hereinafter referred to as “the Winterroth et al. ‘781 patent”); rejected claims 2 and 7 under 35 U.S.C. §103(a) as being unpatentable over the Munro ‘821 patent and the Winterroth et al. ‘781 patent in view of the Nakata

et al. '174 patent; and rejected claims 8 and 10 under 35 U.S.C. §103(a) as being unpatentable over the Munro '821 patent and the Winterroth et al. '781 patent in view of the Hasenkamp et al. '237 patent; and rejected claim 11 under 35 U.S.C. §103(a) as being unpatentable over the Munro '821 patent, the Winterroth et al. '781 patent, and the Nakata et al. '174 patent in view of the Ecklund et al. '402 patent.

By this Response and Amendment Applicant traverses the Examiner's rejections.

Rejections Under 35 U.S.C. §102

1. The Cakmakci '014 Patent

The Examiner rejected claims 1, 2 and 4 under 35 U.S.C. §102(b) as being anticipated by the Cakmakci '014 Patent.

Response

By this Response and Amendment, Applicant notes the Examiner's March 18, 2005 Advisory Action wherein the Examiner indicated that Applicant's February 22, 2005 reply overcame the rejection under 35 U.S.C. 102(b) as being anticipated by the Cakmakci '014 patent. Applicant notes that this rejection has been withdrawn.

2. The Shanahan et al. '327 Patent

The Examiner rejected claims 1, 2 and 4 under 35 U.S.C. §102(e) as being clearly anticipated by the Shanahan et al. '327 patent.

Response

By this Response and Amendment, the rejection to claim 1 and the claims dependent thereon are respectfully traversed.

Applicant notes a March 14, 2005 telephone call between the Examiner and the Applicant's representative, wherein the Examiner indicated that Applicant's second South African priority document, number 99/4442 has a filing date of July 8, 1999. The cited Shanahan et al. '327 patent has a filing date of July 2, 1999. A declaration under 37 C.F.R. §1.131 has been submitted with this Response and show evidence of a date of conception and reduction to practice prior to the July 2, 1999 filing date of the patent application resulting in the Shanahan et al. '327 patent. Thus, it is respectfully submitted that the Shanahan et al. '327 patent is an improper reference as the Applicant has properly sworn behind the Shanahan et al. '327 patent.

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection under 35 U.S.C. §102(e).

Rejections Under 35 U.S.C. §103(a)

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) that some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

1. The Shanahan et al. '327 Patent In View of the Munro '821 Patent

The Examiner rejected claims 3 and 9 as being unpatentable over the Shanahan et al. '327 patent in view of the Munro '821 patent.

Response

Applicant respectfully traverses the Examiner's rejections. The arguments above with

respect to the Shanahan et al. '327 patent are herein incorporated by reference.

Independent claim 1, from which claims 3 and 9 depend, recites an “[a]pparatus for applying a plastic edge strip on an edge of a plate-like workpiece, a wooden board, a chip or particle board, or a board of wood-like particles, comprising: extrusion means for extruding a strand of plastic material on an edge of the workpiece; and forming means for forming the extruded strand of plastic material in a desired profile comprising at least one rotatable roller having a circumferential profile substantially corresponding with the desired profile of the strand of plastic material applied on the edge of the workpiece and further having projections or recesses or projections and recesses to provide the surface of the extruded strand of plastic material with ornamentation or a pattern as well as the profile; the desired profile of the strand of plastic material is provided by the extruded strand being squeezed between the forming means and the edge of the workpiece.”

The Munro '821 patent teaches a hand-held trigger operated adhesive hot melt gun. Munro further teaches the use of pressure rollers that can aid in the application of the adhesive to a curved surface. These pressure rollers are positioned in groups of three.

Contrastingly, nowhere does the Munro '821 patent teach or suggest a “forming means for forming the extruded strand of plastic material in a desired profile,” the forming means “comprising at least one rotatable roller... having projections or recesses or projections and recess to provide the surface of the extruded strand of plastic material with ornamentation or a pattern...” as recited in independent claim 1. Rather, the group of pressure rollers disclosed in the Munro '821 patent simply acts to shape the adhesive to the curved surface – nothing more. The rollers themselves do not have projections and recesses for providing the surface of an extruded strand of plastic material with ornamentation or a pattern. Thus, as all of the features of

the presently claimed invention are neither taught nor suggested by the cited prior art, the presently claimed invention is patentable thereover.

Applicant asserts that, as it is axiomatic that dependent claims contain all of the features of the independent claim from which they depend and as the Munro '821 patent does not teach or suggest a roller as recited in claim 1, the claim from which claims 3 and 9 both depend, the presently claimed invention is patentable thereover.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the rejection to claims 3 and 9.

2. The Shanahan et al. '327 Patent In View of the Nakata et al. '174 Patent

The Examiner rejected claim 7 as being unpatentable over the Shanahan et al. '327 patent in view of the Nakata et al. '174 patent.

Response

Applicant respectfully traverses the Examiner's rejections. The arguments above with respect to the Shanahan et al. '327 patent are herein incorporated by reference.

Independent claim 1, from which claim 7 depends, recites an “[a]pparatus for applying a plastic edge strip on an edge of a plate-like workpiece, a wooden board, a chip or particle board, or a board of wood-like particles, comprising: extrusion means for extruding a strand of plastic material on an edge of the workpiece; and forming means for forming the extruded strand of plastic material in a desired profile comprising at least one rotatable roller having a circumferential profile substantially corresponding with the desired profile of the strand of plastic material applied on the edge of the workpiece and further having projections or recesses or projections and recesses to provide the surface of the extruded strand of plastic material with

ornamentation or a pattern as well as the profile; the desired profile of the strand of plastic material is provided by the extruded strand being squeezed between the forming means and the edge of the workpiece.”

The Nakata et al. ‘174 patent discloses an apparatus for attaching a molding to a peripheral edge of an article. The Nakata et al. ‘174 patent teaches a device comprising rolls that, as described in column 2, lines 35 to 40 of the cited patent, may serve for forming the molding in a shape suitable for covering the edge of the article. As is shown in Fig 18. of the Nakata et al. ‘174 patent, the rolls of the device disclosed in the cited patent mainly serve for further pressing the extruded strand to the edge of the workpiece, not for providing a patterned ornamentation to the strand.

In contrast, independent claim 1 of the present invention recites a “forming means for forming the extruded strand of plastic material in a desired profile,” the forming means “comprising at least one rotatable roller... having projections or recesses or projections and recess to provide the surface of the extruded strand of plastic material with ornamentation or a pattern....” Either or both the projections and recess of the rollers provide a patterned ornamental feature to the plastic material. This feature is simply not present in the Nakata ‘174 patent. Nowhere in its disclosure does the Nakata ‘174 patent teach or suggest “provid[ing] the surface of [an] extruded strand of plastic material with ornamentation or a pattern as well as the profile.” Thus, as all of the features of the presently claimed invention are neither taught nor suggested by the cited prior art, the presently claimed invention is patentable thereover.

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections of claim 7.

3. The Shanahan et al. ‘327 Patent In View The Hasenkamp et al. ‘237 Patent

The Examiner rejected claim 8 under 35 U.S.C. §103(a) as being unpatentable over the Shanahan et al. ‘327 patent in view of the Hasenkamp et al. ‘237 patent.

Response

Applicant respectfully traverses the Examiner’s rejections. The arguments above with respect to the Shanahan et al. ‘327 patent are herein incorporated by reference.

Independent claim 1, from which claim 8 depends, recites an “[a]pparatus for applying a plastic edge strip on an edge of a plate-like workpiece, a wooden board, a chip or particle board, or a board of wood-like particles, comprising: extrusion means for extruding a strand of plastic material on an edge of the workpiece; and forming means for forming the extruded strand of plastic material in a desired profile comprising at least one rotatable roller having a circumferential profile substantially corresponding with the desired profile of the strand of plastic material applied on the edge of the workpiece and further having projections or recesses or projections and recesses to provide the surface of the extruded strand of plastic material with ornamentation or a pattern as well as the profile; the desired profile of the strand of plastic material is provided by the extruded strand being squeezed between the forming means and the edge of the workpiece.”

The Hasenkamp et al. ‘237 patent discloses improvement of a surface of a wood-based material by applying a formable coating material, smoothing the coating material, and heating the coating material. The cited patent discloses applying a decorative layer to the surface of a wood-based material; however, the cited reference does not teach or suggest applying such a decorative layer to the surface of a material using a roller having a surface, which has projections and/or recesses thereon. In fact, the Hasenkamp et al. ‘237 patent teaches away from using rollers

“having a circumferential profile substantially corresponding with the desired profile of the strand of the plastic material applied on the edge of the workpiece,” as recited in claim 1. The Hasenkamp et al. ‘237 patent discloses that “[The coating material] is preferably applied to the surface by means of a transfer tape. This has the advantage that there is no need for an applicator roller adapted to the profile to be coated in order to apply the material.” *The Hasenkamp et al. ‘237 Patent* at col. 2, lines 17 – 23. As such, claim 8, which contains all of the limitations of independent claim 1, is patentable over the Hasenkamp et al. ‘237 patent as this reference neither teaches nor suggests all of the limitations of independent claim 1 from which claim 8 depends.

Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

4. The Shanahan et al. ‘327 Patent And The Munro ‘821 Patent In View The Hasenkamp et al. ‘237 Patent

The Examiner rejected claim 10 as being unpatentable over the Shanahan et al. ‘327 patent and the Munro ‘821 patent in view of the Hasenkamp et al. ‘237 patent.

Response

Applicant respectfully traverses the Examiner’s rejections. The arguments above with respect to the Shanahan et al. ‘327 patent, and the arguments with respect to the Munro ‘821 patent and the Hasenkamp et al. ‘237 patent are herein incorporated by reference.

As Applicant has shown above that independent claim 1, the claim from which claim 10 depends, is patentable over the cited references, claim 10 is patentable thereover for at least the same reasons.

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection to claim 10.

5. The Shanahan et al. ‘327 Patent In View The Ecklund et al. ‘402 Patent

The Examiner rejected claim 11 under U.S.C. §103(a) as being unpatentable over the Shanahan et al. ‘327 patent in view the Ecklund et al. ‘402 patent.

Response

Applicant respectfully traverses the Examiner’s rejections. The arguments above with respect to the Shanahan et al. ‘327 patent are herein incorporated by reference.

Independent claim 1, from which claim 11 depends, recites an “[a]pparatus for applying a plastic edge strip on an edge of a plate-like workpiece, a wooden board, a chip or particle board, or a board of wood-like particles, comprising: extrusion means for extruding a strand of plastic material on an edge of the workpiece; and forming means for forming the extruded strand of plastic material in a desired profile comprising at least one rotatable roller having a circumferential profile substantially corresponding with the desired profile of the strand of plastic material applied on the edge of the workpiece and further having projections or recesses or projections and recesses to provide the surface of the extruded strand of plastic material with ornamentation or a pattern as well as the profile; the desired profile of the strand of plastic material is provided by the extruded strand being squeezed between the forming means and the edge of the workpiece.”

The Ecklund ‘402 patent discloses an apparatus for feeding a flat article along a linear path of travel, extruding a continuous ribbon of thermoplastic resin, applying a pressure against the ribbon to frictionally conform the ribbon about the edge of the flat article, and thereafter applying roll pressure to the ribbon on opposite sides of the article to firmly bond the ribbon thereto.

In contrast to the presently claimed invention, however, the Ecklund ‘402 patent does not

teach or suggest a “rotatable roller having a circumferential profile substantially corresponding with the desired profile of the strand of plastic material applied on the edge of the workpiece and further having projections or recesses or projections and recesses to provide the surface of the extruded strand of plastic material with ornamentation or a pattern...” as recited in independent claim 1. As such, claim 11, which contains all of the limitations of amended independent claim 1, is patentable over the Ecklund ‘402 patent for at least the same reasons as claim 1.

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection to claim 11.

6. The Munro ‘821 Patent In View The Winterroth et al. ‘781 Patent

The Examiner rejected claims 1, 3, 4 and 9 under 35 U.S.C. §103(a) as being unpatentable over the Munro ‘821 patent in view of the Winterroth et al. ‘781 patent.

Response

By this Response and Amendment, Applicant notes the Examiner’s March 18, 2005 Advisory Action wherein the Examiner indicated that Applicant’s February 22, 2005 reply overcame the rejection under 35 U.S.C. 103(a) where Munro was the primary reference. Applicant notes that this rejection has been withdrawn.

7. The Munro ‘821 Patent And the Winterroth et al. ‘781 Patent In View Of The Nakata ‘174 Patent

The Examiner rejected claims 2 and 7 under 35 U.S.C. §103(a) as being unpatentable over the Munro ‘821 patent and the Winterroth et al. ‘781 patent in view of the Nakata et al. ‘174 patent.

Response

By this Response and Amendment, Applicant notes the Examiner's March 18, 2005 Advisory Action wherein the Examiner indicated that Applicant's February 22, 2005 reply overcame the rejection under 35 U.S.C. 103(a) where Munro was the primary reference. Applicant notes that this rejection has been withdrawn.

8. The Munro '821 Patent and the Winterroth et al. '781 Patent In View of The Hasenkamp et al. '237 Patent

The Examiner rejected claims 8 and 10 as being unpatentable over the Munro '821 patent and the Winterroth et al. '781 patent in view of the Hasenkamp et al. '237 patent.

Response

By this Response and Amendment, Applicant notes the Examiner's March 18, 2005 Advisory Action wherein the Examiner indicated that Applicant's February 22, 2005 reply overcame the rejection under 35 U.S.C. 103(a) where Munro was the primary reference. Applicant notes that this rejection has been withdrawn.

9. The Munro '821 Patent, The Winterroth et al. '781 Patent, and the Nakata et al. '174 Patent In View of the Ecklund et al. '402 Patent

The Examiner rejected claim 11 under 35 U.S.C. §103(a) as being unpatentable over the Munro '821 patent, the Winterroth et al. '781 patent, and the Nakata et al. '174 patent in view of the Ecklund et al. '402 patent.

Response

By this Response and Amendment, Applicant notes the Examiner's March 18, 2005

Advisory Action wherein the Examiner indicated that Applicant's February 22, 2005 reply overcame the rejection under 35 U.S.C. 103(a) where Munro was the primary reference. Applicant notes that this rejection has been withdrawn.

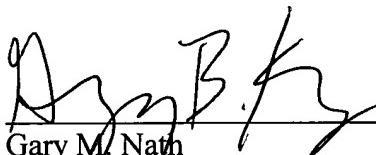
CONCLUSION

In light of the foregoing, Applicant submits that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicant respectfully requests that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,
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